

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed:
April 24, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Clearwater Marine Aquarium

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Serial No. 85865851

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Frank R. Jakes of Johnson, Pope, Bokor Ruppel & Burns, LLP for Clearwater Marine Aquarium.

Katherine S. Chang, Trademark Examining Attorney, Law Office 115 (John Lincoski, Managing Attorney).

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Before Kuhlke, Ritchie, and Masiello, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

Clearwater Marine Aquarium (“Applicant”) filed an application to register on the Principal Register the mark HOPE in standard character form for the following services:

Conducting entertainment exhibitions in the nature of marine aquarium and marine exhibitions, educational demonstrations, live performances by aquatic mammals, and shows involving dolphins, trainers, music and/or audience participation, in International Class 41.¹

¹ Application Serial No. 85865851 was filed on March 4, 2013 under Trademark Act § 1(a), 15 U.S.C. § 1051(a), with a claim of first use and first use in commerce as of April, 2011.

The Examining Attorney refused registration under Sections 1, 2, 3, and 45 of the Trademark Act, 15 U.S.C. §§ 1051-1053 and 1127, on the ground that the proposed mark, as shown on the specimens of record, fails to function as a service mark. When the refusal was made final, Applicant filed a notice of appeal and a request for reconsideration. The Examining Attorney denied the request for reconsideration and this appeal proceeded. Applicant and the Examining Attorney filed briefs, and Applicant filed a reply brief.

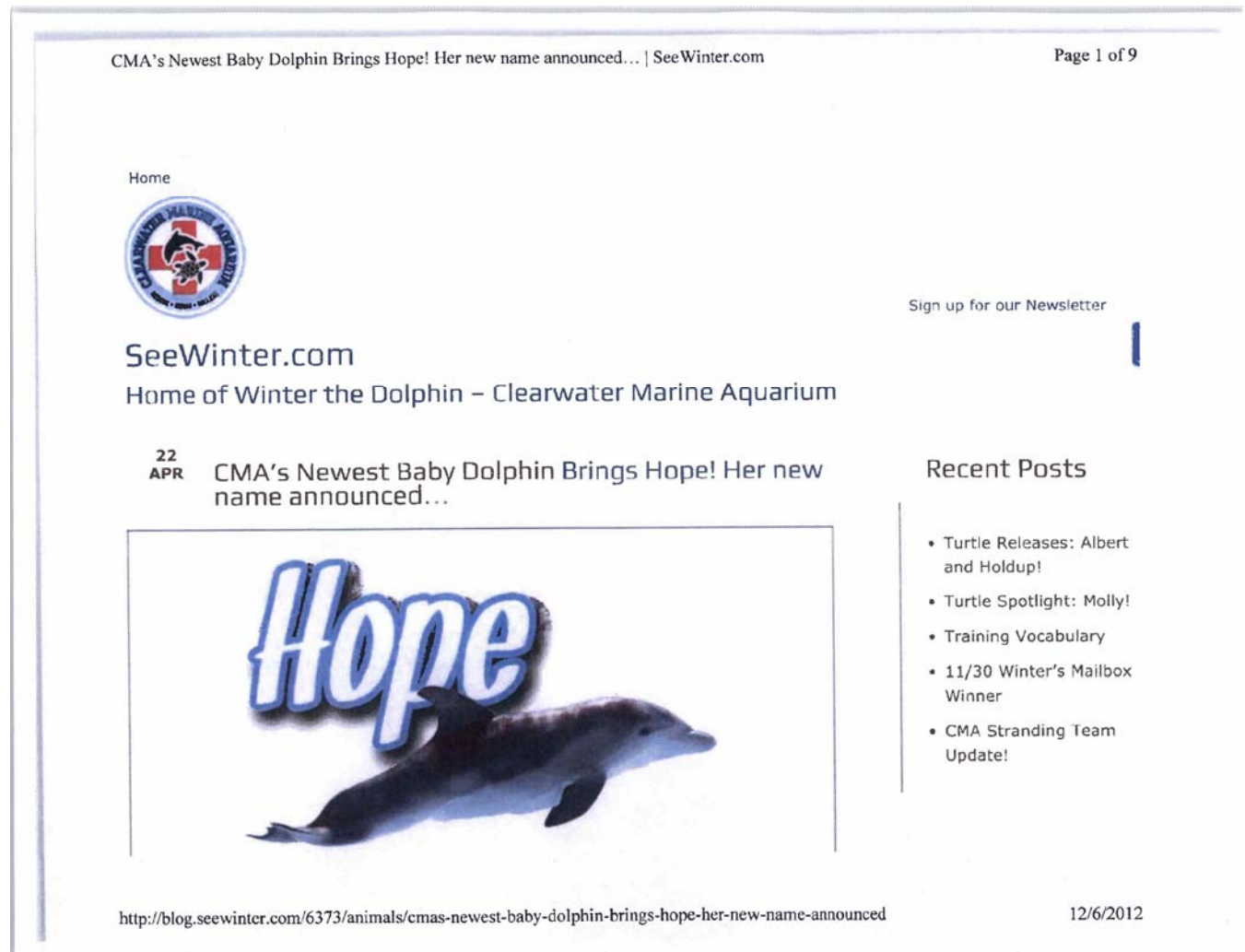
As explained in Applicant's brief, Applicant is "a not-for-profit organization dedicated to the rescue, rehabilitation and release of marine life. Applicant's mission is supported, in part, through admission fees paid by the visiting public when visiting the aquarium."² As part of its activities, Applicant rescued a baby Atlantic bottle nosed dolphin which "survived the rescue and has been named 'Hope.'"³

The specimens of use submitted with the application as originally filed are excerpts of websites of Applicant. (As filed in electronic format, they consist of two .pdf pages from one website and one .pdf page from another.) Although the Examining Attorney advised Applicant that it could file substitute specimens, Applicant did not do so.

The first page of the specimens of use includes the most prominent display of the proposed mark and is shown below:

² Applicant's brief at 3, 9 TTABVue 4.

³ *Id.* at 4, 9 TTABVue 5.



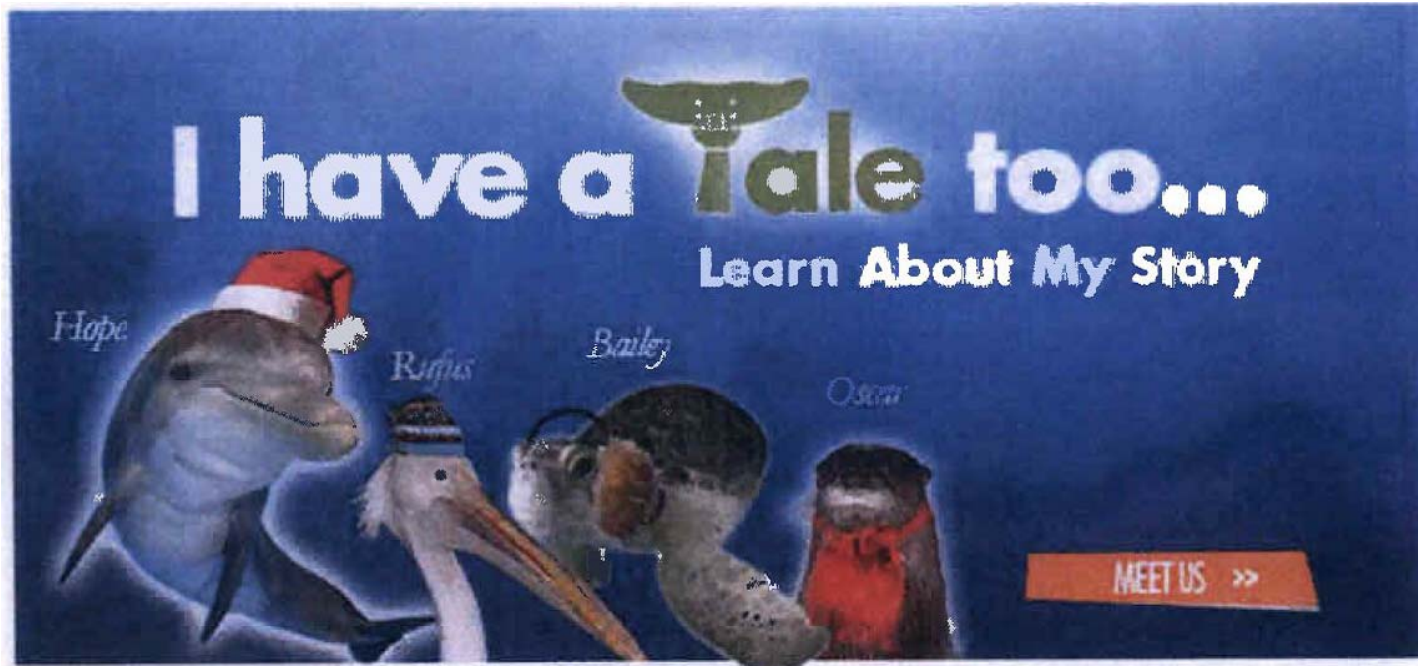
The circular logo near the upper-left corner includes, around its circumference, the words CLEARWATER MARINE AQUARIUM. Each of the other pages of the specimens includes a prominent display of the words CLEARWATER MARINE AQUARIUM. Other wording of note includes the following:

The new baby dolphin remained nameless until today!
Come meet HOPE, Clearwater Marine Aquarium's
newest resident baby dolphin!

...

The calf has been under 24/7 care at CMA since [her
rescue], receiving rehabilitation. ... She is visible to the
public at this time.

The third page of the original specimen of use includes, among other matter, the following image:



Section 45 of the Trademark Act provides, in relevant part, that a service mark is a mark that is used “to identify and distinguish the services of one person ... from the services of others and to indicate the source of the services”; and that “a mark shall be deemed to be in use in commerce ... on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce.”⁴ In order to demonstrate use of a service mark by means of an advertisement, the advertisement must display the mark “in a manner that would be perceived by potential purchasers as identifying the applicant's services and indicating their source via a ‘direct association.’” *In re DSM Pharmaceuticals Inc.*, 87 USPQ2d 1623, 1624 (TTAB 2008). “The minimum requirement is some direct association between

⁴15 U.S.C. § 1127, definitions of “service mark” and “use in commerce.”

the offer of services and the mark sought to be registered therefor.” *In re Universal Oil Products Co.*, 476 F.2d 653, 177 USPQ 456, 457 (C.C.P.A. 1973). The matter presented for registration must be of such a nature that purchasers would be likely to consider that it indicates the origin of the services. *In re Whataburger Systems, Inc.*, 209 USPQ 429, 430 (TTAB 1980).

The examining attorney argues as follows with respect to the designation HOPE as it appears on the specimens of use submitted by Applicant:

The applied-for mark ... is used simply as the name of the dolphin; it is not used in connection with the identified services and therefore does not serve as an indicator of source.

...

The advertising, promotion and marketing ... shown in the specimens relates to the dolphin, not to the services identified in the application. The first specimen (the first two pages) discusses Hope’s birth and then-current status. ... [I]t does not show that any services are offered in connection with the proposed mark. The specimens show that applicant uses the proposed mark *simply* to refer to the dolphin ...

Examining Attorney’s brief, 11 TTABVUE 3-4.

Although the specimens display the term HOPE on the same page with references to “Clearwater Marine Aquarium,” which is a suitable reference to the services identified in the application as “exhibitions in the nature of marine aquarium and marine exhibitions,” the question is whether the term HOPE, as displayed in the specimens, functions as a service mark for the applied-for services.

There is no reason why the name of a dolphin that appears in Applicant’s aquarium exhibits cannot also function as a service mark for those exhibition

services. *See In re Mancino*, 219 USPQ 1047, 1048 (TTAB 1983) (“The Board has held on more than one occasion that an individual’s name may function to identify both the individual and the ... services rendered by that individual.”). In cases where an applicant seeks to register the name of a person or character as a service mark for performance services, the Board has required “that the specimens filed with the application demonstrate use of the name in question to identify ... services rendered by the applicant corporation as distinguished from use merely to identify the particular individual who endorses the goods or performs the services set forth in the application.” *In re Lee Trevino Enterprises, Inc.*, 182 USPQ 253, 253 (TTAB 1974); *In re Carson*, 197 USPQ 554, 555 (TTAB 1977) (“[S]uch a name may be registered provided that the specimens filed with the application evidence use of the name not just to identify the individual but rather to identify goods sold or services rendered by the applicant in commerce.”) These references to “identify[ing] goods sold or services rendered” cannot be properly understood without consideration of the additional statutory requirement of every service mark, namely, that it not solely “identify” the services but must also “indicate the source of the services.” 15 U.S.C. § 1127.

Applicant admits that HOPE is “the name of one of the rescued Atlantic nose bottle [*sic*] dolphins being cared for at Applicant’s facility”; but argues, “How else to advertise, promote and market to prospective visitors without using the name of one

of the more popular and known dolphins in Applicant's care? Indeed, it is impossible to sever the connection."⁵ Applicant's argument continues:

It is undisputed that the specimen constitutes advertising seeking to draw visitors to view the facilities and exhibitions including the dolphin, Hope.

...

Here, the specimen clearly refers to the Applicant's aquarium, mentions tickets and invites viewers to "visit" – all in conjunction with HOPE. Thus, the direct connection between the mark and the services is unquestionably demonstrated in the specimen.⁶

Applicant uses the HOPE brand prominently and throughout its website in a manner to attract attention to the very services ... which are the subject of the application. It is chimerical for the Examiner to suggest that there is a bright demarcation line between use of the Hope name as an identifier for the dolphin and use of the HOPE brand as a mark promoting the subject services of the applicant. As is clearly reflected by the supporting specimen, Applicant prominently uses the HOPE brand to attract visitors, donors and others interested in its entertainment exhibits ...

... [T]he specimen clearly invites visitors to view video directly related to Hope's arrival at Applicant's rescue and rehabilitation facility. ... This "exhibition" is repeated [at p. 3 of the specimen] where visitors are invited to visit Applicant's facility, meet Hope as well as watch other videos related to Hope.⁷

Upon careful review of Applicant's specimens, we find that the designation HOPE is used in the submitted specimens only as the name of the baby dolphin. We agree that Applicant's specimens are advertisements seeking to draw visitors to

⁵ Applicant's brief at 5, 9 TTABVUE 6.

⁶ *Id.* at 6-7, 9 TTABVUE 7-8.

⁷ Applicant's reply brief at 2-3, 12 TTABVUE 3-4.

Applicant's exhibition services, and that references to Hope the baby dolphin are used as an attraction to customers. However, we do not agree that "Applicant uses the HOPE *brand* ... to attract attention" to its services. All uses of HOPE in the specimens refer to the *name* of an animal that is included in Applicant's exhibits, and not to an entertainment service provided thereby. These references include the two phrases "Her new name announced ... Hope" and "Come meet HOPE, Clearwater Marine Aquarium's newest resident baby dolphin!"; and the photograph of the dolphin with the name "Hope" next to her head, alongside three other animals, all with their names displayed near their heads. Promoting the exhibition of an animal named Hope as a feature of Applicant's services does not automatically cause the name of that exhibited animal to function as an indicator of the source of Applicant's services. Given the manner of its use, relevant customers would perceive HOPE, as displayed in the specimens, only as the name of the exhibited dolphin. They would not perceive it as a symbol of the source of Applicant's services, which is the function of a service mark as defined in the Trademark Act. *See In re Whataburger Systems, Inc., supra* (one of a series of named animal characters displayed on promotional gifts does not function as a service mark).

Applicant suggests that the Examining Attorney's refusal is based upon a "bias against an animal's name as serving as a trademark."⁸ This argument is off-point, because the Examining Attorney, in her Office Actions, indicated that her refusal might be overcome by the submission of substitute specimens. If Applicant had

⁸ Applicant's brief at 7, 9 TTABVue 8.

submitted substitute specimens that showed HOPE functioning as a service mark, the mark would be registrable even though the original specimens show that Applicant also uses HOPE as the name of a dolphin. Applicant did not submit any additional specimens of use. Accordingly, this record shows use of the designation HOPE only as the name of a dolphin.

We have considered the phrase “CMA’s Newest Baby Dolphin Brings Hope!,” which appears in the first specimen of use. The word “Hope” in this phrase appears to be a punning reference to the new name of the baby dolphin and the abstract concept of “hope” in the sense of a favorable expectation. This phrase is, of course, not the mark that Applicant seeks to register. Moreover, this use of the word “hope” does not constitute a display of the mark HOPE because the word is inextricably embedded within a complex phrase and would not be perceived as a separate symbol of the source of Applicant’s services.

Applicant argues that “In U.S. Reg. No. 1,798,255, the Office granted SeaWorld a service mark registration for SHAMU in Class 41 for “... live performances by aquatic mammals; ... shows involving killer whales ...”⁹ Applicant did not make the registration of record,¹⁰ but it did submit what Applicant contends is the specimen of use on which the USPTO based its decision to register the mark.¹¹ (We note that the specimen bears a date of “7/22/2013,” which is many years later than the likely

⁹ Applicant’s brief at 5, 9 TTABVUE 6.

¹⁰ The Board does not take judicial notice of registrations residing in the USPTO. *Edom Labs. Inc. v. Lichter*, 102 USPQ2d 1546, 1550 (TTAB 2012); *See also In re Sela Products LLC*, 107 USPQ2d 1580, 1583 (TTAB 2013).

¹¹ Applicant’s request for reconsideration filed July 7, 2014 at 7-8.

issue date of a registration bearing this number. It is more likely that the specimen submitted was filed after registration with a declaration of use or with a request for renewal.) In any event, we must decide each case on its own merits, and the decisions of examining attorneys to allow the registration of other marks are not binding on the Board. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). The same must be said of the issuance to Applicant of Reg. No. 3383302 for the service mark WINTER,¹² which is the name of another of Applicant's dolphins.

After careful consideration, we find that the designation HOPE, as used on the specimens of use, does not function as a service mark, as it would not be perceived by potential customers as indicating the source of Applicant's services.

Decision: The refusal to register is affirmed.

¹² See Applicant's brief at 6, 9 TTABVue 7. That registration and its file history are also not of record.